

REMARKS

In accordance with the foregoing, no claims have been amended, cancelled, or added. No new matter has been entered. Therefore, claims 12-28, 33 and 34 are pending and reconsideration is respectfully requested.

ENTRY OF AMENDMENT UNDER 37 C.F.R. § 1.116:

Applicants request entry of this Rule 116 Response because it is believed that the amendment of claims 1, 4 and 11 places this application into condition for allowance and because the amendments should not entail any further search by the Examiner since no new features are being added or no new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

DOUBLE PATENTING:

In the Office Action, claim 27 and 28 were rejected under the judicially created doctrine of double patenting over claim 18 and 28 of co-pending application No. 10/737,837. However, it is respectfully submitted that since neither the present set of claims nor the claims in co-pending application No. 10/737,837 have been formally allowed, it would be premature to address the double patenting rejection at this time.

INFORMAL TELEPHONE CONFERENCE OF 10/6/05:

Applicants wish to thank the Examiner for his participation in the informal telephone conference of October 6, 2005, and note that although no formal agreement was reached as to the patentability of the claims, applicants understand that the Examiner indicated that the following positions and arguments would be considered persuasive.

REJECTIONS UNDER 35 U.S.C. §103:

Claims 12-14, 17-28 and 33-34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morishita (U.S. Patent 5,976,729) in view of Watanabe (U.S. Patent 6,492,058) and as evidenced by Pedicini (U.S. Patent 5,188,909) (hereinafter referred to as "the first set of rejections"), claims 15 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morishita and Watanabe as applied to claim 12 above, and further in view of Pedicini, and claims 12-14, 17-28 and 33-34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morishita, Watanabe and Pedicini in view of Takahashi (U.S. Publication 2001/0038938) (hereinafter referred to as "the third set of rejections").

Regarding the rejection of claim 12 in the first set of rejections, it is noted that claim 12 recites a lithium battery comprising a generation element which generates electrical power, a can which houses the generation element and which has a first surface and a second surface, the first surface comprising a first terminal electrically connected to the generation element and the second surface comprising a second terminal electrically connected to the generation element, and a lead unit, external to the can, which electrically connects the first terminal and the second terminal through a safety device and having a lead plate with one end disposed at the first surface and another end disposed at the safety device.

According to the Office Action however, this claim is rendered obvious by the combination of the cited references. In particular, the Examiner has suggested taking the protection circuit and lead structure of Watanabe, on the presumption that these features disclose the claimed lead unit and safety device, modifying these features by suggesting that they may be attached external to a cell housing even though Watanabe discloses these features as being interior to the battery pack, and combining these features with the teachings of Morishita. Responsively, considering that the Examiner appears to be applying his own engineering experience, knowledge, and hindsight, by modifying the teachings of Watanabe and then incorporating the modified teachings into Morishita so as to modify that reference also, applicants submit that the two-layer modification of the references that is described above would have been anything but obvious to a person skilled in the art at the time of the claimed invention.

Moreover, these suggestions all come despite the fact the neither Morishita nor Watanabe include any evidence that the suggested combination would be desirable, as is necessary for a prima facie case of obviousness. Indeed, it is clear that Watanabe actually teaches away from the protection circuit and lead structure being exterior to the case. Further, it is also clear that Morishita includes a protection circuit and lead structure of its own. Thus, while the teachings of Morishita are entirely different from that of the claimed invention, a combination of the protection circuit and lead structure of Watanabe and Morishita appear redundant given

the operation of Morishita. Thus, it can be said that Morishita also teaches away from the suggested combination.

Therefore, it is respectfully asserted that claim 12 is patentably distinguished over any combination of the cited references is this set of rejections.

Regarding the rejection of claim 33 in the first set of rejections, it is noted that claim 33 recites similar features as claim 12 and is patentably distinguished over any combination of the references for substantially similar reasons as set forth above.

Regarding the rejections of claims 13, 14, 17-28 and 34 in the first set of rejections, it is noted that these claims are patentably distinguished over any combination of the references due at least upon their dependence on claims 12 and 33, respectively.

Regarding the rejection of claim 12 in the third set of rejections, it is noted that the addition of the reference to Takahashi is being relied upon for the teaching that a lead unit and a PTC may be placed externally to a cell housing. Applicants respond by noting that this set of rejections remains defective because the Examiner remains reliant upon the suggested modifications described above (i.e. the modified teachings of Watanabe incorporated into Morishita so as to modify Morishita) which have been shown to be defective themselves.

That said, the addition of Takahashi does not cure any of the defects of the suggested modifications. Takahashi does not change the fact that Morishita already contains a lead unit and a protection circuit that render a combination of Morishita and Watanabe redundant given the operation of Morishita and it does not change the fact that Watanabe specifically teaches away from the placement of a lead unit and a protection circuit external to the cell housing.

Moreover, the addition of Takahashi with any combination of the other references or alone with Morishita does not, and is not cited, as rendering the claimed invention obvious.

Therefore, it is respectfully asserted that claim 12 is patentably distinguished over any combination of the cited references is the third set of rejections.

Regarding the rejection of claim 33 in the third set of rejections, it is noted that claim 33 recites similar features as claim 12 and is patentably distinguished over any combination of the references for substantially similar reasons as set forth above.

Regarding the rejections of claims 13, 14, 17-28 and 34 in the third set of rejections, it is noted that these claims are patentably distinguished over any combination of the references due at least upon their dependence on claims 12 and 33, respectively.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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